

REMARKS

Claims 1-27 are pending in this application.

The Examiner has rejected claims 1-27 under the judicially created doctrine of double patenting over claims 1-33 of US Patent 6,492,330. Applicants respectfully traverse the rejection.

Claim 1 of this application defines a peptide X-Leu-Met-Tyr-Pro-Thr-Leu-Lys-Y wherein X is acetyl or straight, branched or cyclic alkanoyl group from 3-16 carbon atoms and Y is carboxyl terminal residue selected from OH or amino; or a pharmaceutically acceptable salt of the peptide.

None of the peptides defined in the claims of this application are obvious in view of the peptides claimed in US Patent 6,492,330. None of the peptides claimed in US Patent 6,492,330 include a group X where X is acetyl or straight, branched, or cyclic alkanoyl group from 3 to 16 carbon atoms.

The Examiner has provisionally rejected 1-27 under the judicially created doctrine of obvious double type patenting of being unpatentable of claims 1,3,4 and 32-36 co-pending application 09/248,381. Applicants respectfully traverse this rejection.

Firstly, it is noted that US Patent application 09/248,381 issued as US Patent 6,492,330. Applicant are proceeding on the basis that the application that was meant by the Examiner is US Patent application 09/248,382. None of the claims in this application are obvious over claims 1,3,4 and 32 to 36 of US Patent application 09/248,382. The peptides defined in claims 1,3, 4 and 32 to 36 of US Patent application 09/248,382 do not include a group X where X is defined as

above.

In making both these rejections, the Examiner states that both inventions are basically the same since they are made by the same procedure for the same purpose. There is no legal or factual basis for this statement. Following the Examiner's reasoning could mean that once one patent has been granted for a compound that can be prepared by a standard chemical reaction such as a Diels-Alder reaction and the compound can be used to treat, for example, lung cancer; no other patent could be granted for any other compound that can be prepared by a Diels-Alder reaction and can be used for treating lung cancer because there is already one patent for the same purpose.

The Examiner also states that "both inventions are an obvious variation of the other since the same peptides are used for the same purpose, and as such, one of ordinary skill in the art would envision both sets of claims as one invention and obvious variation of each other." Applicants respectfully disagree.

According to MPEP 2141 when applying 35 USC 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and (D) reasonable expectation of success is the standard with which obviousness is determined.

US patent 6,492,330 and US Patent application 09/248,382 do not suggest the use of an X group as an acetyl or alkanoyl group. There is no

suggestion in US Patent 6,492,330 or US Patent application 09/248,382 that the peptides claimed in the patent and application could be modified and that once modified could be used to treat cancer.

In addition, in making this rejection, the Examiner is relying on impermissible hindsight.

A reference must be considered for what it would teach someone skilled in the art at the time the invention was made and not be applied based on "hindsight". See *Panduit Corp. v. Dennison Manufacturing Co.* 227 USPQ 337, 343 (Fed. Cir. 1985):

It is impermissible to first ascertain factually what applicants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art.

In making its obviousness determination, a court must view the prior art without reading into that art the patent's teachings. *Vandenberg v. Dairy Equipment*, 224 U.S.P.Q. 195 (Fed. Cir. 1987) citing *In re Sponnoble*, 160 U.S.P.Q. 237 (CCPA 1969). In *Uniroyal . Rudkin-Wiley*, 50 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) the CAFC stated:

The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decision maker to return to the time the invention was made. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time...That which may be clear and thus obvious to a court, with the invention fully diagramed and aided by experts in the


field, may have been a breakthrough of substantial dimension when first unveiled [citations omitted]. In this case we are convinced that the district court misapplied the obviousness standard. It has impermissibly used hindsight to reconstruct the claimed invention from prior art with the invention before it and aided by Uniroyal's expert, rather than viewing the invention from the position of a person of ordinary skill at the time it was made. When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

Based on these reasons applicants submit that the claims in this application are not obvious over the claims of US Patent 6,402,330 and US Patent application 09/248,382.

Therefore, it is respectfully requested that these rejections be withdrawn.

Accordingly, applicants submit that the present application is in condition for Allowance. Favorably consideration is respectfully conditions.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "Janet I. Cord", written over a horizontal line.

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